REMARKS

Applicant notes with appreciation the withdrawal of the anticipation rejections made based on the Gundberg et al. reference. Currently, claims 1-13 and 22-36 are pending in the application.

Claims 1-13 and 22 are rejected under 35 U.S.C. §112, first paragraph.

Claim 8 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite because Applicant has not yet provided a copy of the procedure used to measure water vapor transmission rate.

Claims 1, 3-5, 11, 12, 22-27, and 31-36 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,876,551 to Jackson "as further evidenced by" the Abstract of WO 95/07946.

Claims 2, 8, and 30 stand rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being obvious over Jackson.

Claims 6-7 and 28-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jackson in further view of Penz et al. (U.S. Patent No. 5,888,913), and with further citation to Gundberg et al. (U.S. Patent No. 6,203,646).

Claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Jackson, as applied to claim 1, and further in view of Melber et al. (U.S. Patent No. 4,898,892).

Rejection of claims 1-13 and 22 under 35 U.S.C. §112, first paragraph

Claims 1-13 and 22 are rejected as allegedly lacking support in the written description provided by the specification. To properly reject a claim under the first paragraph of Section 112 for lack of adequate descriptive support, it must be shown that the originally-filed disclosure would not have reasonably conveyed to a skilled artisan that the Applicant possessed the now claimed subject matter.[1] Adequate description under this section does not, however, require literal support for the claimed invention.[2] Rather, it is

1 Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).
2 In re Herschler, 591 F.2d 693, 200 USPQ 711 (CCPA 1979); In re Edwards, 568 F.2d 1349, 196 USPQ 465

sufficient if the originally filed disclosure would have conveyed to one having ordinary skill in the art that the inventor had possession of the concept of what is claimed.[3]

On page 3 of the final Office Action at paragraph 1(a), the contention is made that there is no "expressed support" in the specification for the limitation that the regular, roller paintable surface is "substantially free of random discontinuities susceptible to creating visible irregularities when roller painted" (Office Action, p. 2, ¶ 1(a)), and that such constitutes impermissible "new matter." However, as noted above, literal or "expressed" support is not required to comply with Section 112, first paragraph. Applicant's specification does indeed provide support for the concept of a "regular" roller paintable surface. As explained in the previous response, "regular" in the context of the invention should be understood to mean "even," "smooth," or "uniform," a contention which has not been refuted. An "even, smooth, or uniform" surface is clearly "free of random discontinuities susceptible to creating visible irregularities when roller painted," as claimed. (Emphasis added).

Since the application reasonably conveyed to a skilled artisan that the Applicant possessed the now claimed subject matter at the time the invention was made (including a description of a "regular" roller paintable surface), the rejections of these claims under Section 112, first paragraph, should be withdrawn.

Rejection of claim 8 under 35 U.S.C. §112, second paragraph

Applicant again acknowledges and accepts the invitation to supply the requested information, and will do so upon receiving an indication of allowable subject matter.

Rejection of claims 1, 3-5, 11, 12, 22-27, and 31-36 under 35 U.S.C. §102(b)

(CCPA 1978); In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).
3 In re Anderson, 471 F.2d 1237, 176 USPQ 331(CCPA1973).

Claims 1 as amended, claims 3-5, 11, 12, 22-27, and 31-35, and new claim 36 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,876,551 to Jackson "as further evidenced by" the Abstract of WO 95/07946.

Claim 1 describes a polymeric wall covering material having a thermoplastic polymer coating applied to the non-woven fiber tissue or mat to provide a regular, roller paintable visible outer surface. This claim further requires that this regular, roller paintable surface formed by the polymer coating is substantially free from random discontinuities susceptible to creating irregularities when the surface is roller painted. Independent claim 23 requires a polymeric wall covering material having a thermoplastic polymer coating material applied to the non-woven fiber tissue to provide a regular, roller paintable visible outer surface, as well as a layer of paint "roller-applied." (Emphasis added).

In making final the rejections of these claims based on Jackson, the previous position that "regular" is "synonymous to normal" and "implies lack of deviation from what has been discovered or established as the most usual or expected" is ostensibly abandoned. Instead, the final Office Action posits that Jackson includes "microscopic discontinuities" in view of the expressed desire for gas permeability. The conclusion is thus reached that "'visible irregularities' would not be created when roller painted since the discontinuities in the polymeric material are microscopic and are not visible to the unaided eye" (Office Action, p. 3, ¶ 1). Nevertheless, nothing in Jackson is alleged to describe any surface characteristics of the disclosed material.

First of all, Applicant respectfully submits that the statement that "visible irregularities" would not be created when the random discontinuities are roller painted is entirely without evidentiary support in the record. No objective evidence is cited in support of this conclusion, as is required to support a *prima facie* case of obviousness.[4] Instead, it is mere speculation that roller painting random discontinuities (which it should be emphasized are described not as mere "surface irregularities," but "holes" or "gaps" in

4 See In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002) ("The factual inquiry whether to combine references must be thorough and searching. . . . It must be based on objective evidence of record.") (Emphasis added).

the layer) in this manner would not result in visible irregularities, since Jackson is completely silent as to the possibility of this result (and for good reason).

Secondly, the current rejection again equates the appearance of the Jackson structure with Applicant's claimed surface, which is what must be "regular." Specifically, Jackson teaches that the porous, polymeric ply has a "smooth, continuous, aesthetically pleasing appearance, while simultaneously achieving a moisture vapor permeability which prevents moisture from being trapped on or within a wall to which the wall covering is applied" (col. 2, ll. 23-27). (Emphasis added). This is accomplished by applying plastisol "very thinly" to the nonwoven substrate ply (which is described as having a "reticular," or net-like, structure (col. 2, l. 45)) "such that . . . small discontinuities, holes, or gaps" are formed that ultimately form miniature holes or pores in this ply (col. 5, ll. 50-52). These holes or gaps in the material are consistently referred to by Jackson as being "randomly distributed" (see, e.g., the Abstract; col. 2, ll. 30-32; col. 3, l. 7), which is no doubt caused by the reticular nature of the underlying substrate.

As observed in the prior response, the surface of the Moon appears generally smooth or regular from the Earth, even though it is actually quite discontinuous and irregular up close. Likewise, the wall covering in Jackson may appear to be smooth when viewed from afar. However, this "apparent" smoothness is irrelevant to the issue of whether it discloses a regular surface and, in particular, one "free of random discontinuities susceptible to creating visible irregularities when roller painted," as claimed.

The position taken in rejecting the claims is that "the present invention also has a degree of gas permeability to allow moisture to escape from underneath" and, therefore, "microscopic discontinuities such as those of Jackson would be recognized in the present invention" (Office Action, p. 3, ¶ 1). However, the gas permeability of the polymeric coating in Applicant's invention or the plastisol coating of Jackson is entirely irrelevant as to whether the surface provided is regular as claimed, since the two concepts are mutually exclusive. Applicant is not claiming that the polymeric coating of claim 1 is not gas

permeable, but rather that it provides the resulting wall covering with a "regular surface" that is "free of random discontinuities susceptible to creating visible irregularities when roller painted." Such is simply not taught in Jackson with the requisite strict identity necessary to support an anticipation rejection, even though it may have random discontinuities that provide gas permeability.

Turning to claim 23, it is also again rejected as anticipated by Jackson without any acknowledgement of the requirement for a layer of paint-roller applied. However, the Action points to nothing in Jackson that discloses the claimed "layer of paint roller-applied" to a thermoplastic polymer coating, which in turn is applied to the outer side of a non-woven fiber tissue or mat. Moreover, nowhere in the Office Action is the contention made that any combination of references teach all limitations of claim 23. Accordingly, it is respectfully submitted that this claim and its progeny (including dependent claims 24-27 and 31-35) should be held allowable, rather than finally rejected.

Notwithstanding the allowability of claims 1 and 23 over Jackson, several of the dependent claims also patentably distinguish over this reference. For example, dependent claims 5 and 27 require that the thermoplastic polymer coating comprises a matrix polymer resin selected from the group consisting of low density polyethylene, high density polyethylene, polypropylene, and combinations thereof. Withdrawing the prior admission made that Jackson "fails to explicitly disclose the use of polyethylene and polypropylene resins," it is nevertheless contended that claims 5 and 27 are anticipated because "the use of resins such as polyethylene in plastisol to produce a coating material is known in the art" (Office Action, ¶5, p. 6)

A finding of anticipation is proper "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a <u>single prior art reference</u>" Section 2131 MPEP, ch. 2100, p. 73. (Emphasis Added). "Normally, only one reference should be used" in making an anticipation rejection. Section 2131.01 MPEP, ch. 2100, p. 73. However, reliance on a second reference in support of an anticipation rejection has been held proper when it is cited to: (1) prove the primary reference contains an enabled

disclosure; (2) explain the meaning of a term used in the primary reference; or (3) show that a characteristic not disclosed in the reference is inherent. Section 2131.01 MPEP, ch. 2100, p. 74.

Despite the withdrawal of the express admission, an implicit admission remains that Jackson does not disclose "each and every element of the claim" as required for a proper anticipation rejection. Nevertheless, reliance on a second reference, WO 95/079946 is made to show that "the use of resins such as polyethylene in plastisol form to produce a coating material is known in the art." That the use of polyethylene in plastisol form is "known in the art" is entirely irrelevant to the consideration of whether Jackson anticipates claims 5 or 27. Applying this logic, no patent would ever issue on a species in combination with another structure simply because the genus without the combination is "known in the art," which simply cannot be the case. Rather, the proper consideration is whether "each and every element as set forth in the claim is found, either expressly of inherently described" in Jackson. Since such is admittedly not the case, the rejections of these claims cannot stand. The Action also fails to address or explain the relevance of WO 95/079946 to Applicant's field of endeavor, which makes it non-analogous (and presumably why reliance is made on the concept of anticipation instead of obviousness in rejecting these claims).

Dependent claim 35 requires that the polymeric material comprises approximately a 45/5/50 by weight mixture of high-density polyethylene, titanium dioxide, and a dispersion comprising of ground calcium carbonate and ground titanium dioxide in high density polyethylene. Applicant finds no such disclosure anywhere within the four corners of Jackson, nor is such a teaching provided by WO 95/07946. Accordingly, the anticipation rejection made is improper and must be withdrawn.

Finally, Applicant previously presented new independent claim 36. This claim as entered reads on a wall covering comprising a non-woven rigid fiber tissue or mat having an inner side and an outer side. According to the claim, a thermoplastic polymer coating is applied to the outer side.

Despite rejecting this claim as anticipated by Jackson, the Office Action points to nothing in this reference that in any way discloses, teaches, or suggests the claimed rigid fiber tissue or mat. Indeed, Jackson is completely silent as to this feature. Accordingly, Applicant respectfully submits that the final rejection of this claim is improper.

Summarizing the foregoing, none of claims 1, 3-5, 11-12, 22-27 and 31-36 is anticipated by Jackson (which cannot properly be combined with WO 95/07946 in support of such rejections). Reconsideration of these claims is thus respectfully requested.

Rejection of Claims 2, 8, and 30 under 35 U.S.C. §102(b)/35 U.S.C. §103(a)

Claims 2, 8, and 30 stand rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being obvious over Jackson. Turning first to dependent claim 2, it requires that the roller paintable, visible outer surface of the thermoplastic polymer coating has a surface tension of at least approximately 30 dynes/cm.

In rejecting this claim, it is acknowledged that Jackson is completely silent as to the claimed surface tension. However, it is allegedly "reasonable to presume" that the "claimed properties" are "inherent" in the material disclosed in this reference.

This naked assertion is contrary not only to the Manual of Patent Examining Procedure, but also precedential Federal Circuit decisions holding that "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."[5] Not only do the steps described for forming the Applicant's claimed wall covering material differ completely from those outlined in Jackson, but Applicant's processing involves a treatment designed to impart a particular surface tension in order to facilitate roller painting. As acknowledged by the Examiner, Jackson is completely silent as to the surface tension of the substrate or any steps taken to alter it, so it cannot possibly anticipate the claimed invention.

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5 See Ex parte Levy, 17 USPQ2d 1461, 1464 (BPAI 1990) and Section 2112, MPEP generally.

With regard to the citation of supporting authority made in the Office Action, Applicant notes that the proposition for which the cases are advanced does not apply on the present facts. The dated decisions of In re Fitzgerald, 205 USPQ 594 (CCPA 1980) and In re Best, 195 USPQ 433 (CCPA 1977) stand for the proposition that where "claimed and prior art products are identical or substantially identical, or are **produced by identical or substantially identical processes**, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product." Id. (Emphasis added). Here, Applicant has met its burden by demonstrating that the products are not identical or substantially identical, and clearly not produced using identical or substantially identical processes, since Jackson fails to mention any corona discharge treatment. Thus, the holdings of these decisions are inapposite.

In final analysis, it is **unreasonable** to "presume" that the same end product as set forth in claim 2 would result from Jackson, which does not teach processing in the same or even a similar manner. The same holds true with respect to the water vapor transmission rates of claims 8 and 30, which are not in any way equated with the values of 25 to 50 perms (which is defined by Jackson as being 1 g/m^2 per hour, and thus equates to 600-1200 g/m^2 per day). Accordingly, it is respectfully submitted that the rejections of these claims based on the teachings of Jackson are improper and should be withdrawn.

Rejection of claim 6, 7 and 28-29 under §103(a)

Claims 6, 7 and 28-29 stand rejected as being unpatentable over Jackson in further view of Penz et al. (with further citation to Gundberg et al.) Applicant respectfully traverses these rejections.

Penz et al. discloses a glass mat reinforced thermoplastic suitable for the production of paintable parts comprising a thermoplastic matrix polymer, one or more glass mats, and a fine-particle mineral fiber. It would not be obvious to combine Jackson and Penz et al. to arrive at the present invention, since there is no motivation to do so. Again, the Examiner is utilizing Penz et al. to include a mineral filler in the chemical composition of the

polymeric coating to create a non-smooth surface, when in fact Jackson specifically teaches that such is not desirable. The Action also acknowledges for the first time that Gundberg et al. teaches away from Applicant's invention. Accordingly, these references are simply not properly combinable, and even when combined do not lead to the claimed invention.

Rejection of claim 13 under §103(a)

Claim 13 stands rejected as being unpatentable over Jackson, as applied to claim 1, further in view of Melber et al. Applicant respectfully submits that these references are not properly combinable. On this basis, reconsideration is respectfully requested.

Melber et al. discloses a method for making an opaque coating comprising employing opacifiers into or onto the surface of thermoplastic microspheres. However, no reason is provided as to why one of ordinary skill in the art would modify Jackson as the Office Action proposes. The addition of an opacifying agent of Melber et al. to the coating of Jackson would still not result in a roller paintable outer visible regular surface of a polymeric wall covering material as in claim 13. As such, there would be no reason to combine the opacifying enhancement characteristics described in Melber et al. with Jackson. Hence, this claim is not directed to obvious subject matter in view of the cited prior art, and reconsideration is respectfully requested.

In view of the foregoing amendments and remarks, Applicant submits that claims 1-13 and 22-36 are in proper form and allowable over the cited prior art and respectfully requests consideration of all rejections made. The Examiner is invited to telephone the Applicant's undersigned attorney at (740) 321-7167 if any unresolved matters remain, and may debit any fees due from Deposit Account 50-0568.

Respectfully submitted,

By: Maria C. Gasaway

Maria C. Gasaway
Reg. No. 51,721

Owens Corning
Patent Dept. Bldg. 11
2790 Columbus Road
Granville, Ohio 43023
(740) 321-7213

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